

Remarks

Currently pending in the application are Claims 1-16, 19-22 wherein Claims 1-16, 19 and 20 are rejected, and claims 21 and 22 are newly presented.

In view of the following remarks, Applicant respectfully requests reconsideration by the Examiner, and advancement of the application to allowance.

1. Rejection Under 35 U.S.C. § 103(a)

Claims 1-16 and 19 and 20 stand rejected under 35 U.S.C. § 103(a) as anticipated by U.S. Pat. No. 5,143,945 (Bodnar).

With respect to Claims 1-16 and 19 and 20, the Office Action admits that Bodnar differs from Applicant's claimed inventions in that Bodnar is not particularly limited to Applicant's selection of active hydrogen containing derived polyols of the equivalent weights. The Office Action also admits that Bodnar differs from Applicant's claimed inventions in that Bodnar does not require Applicant's claimed Index values. The Office Action, however, asserts that Applicant's claimed polyol and Index values could have been obtained from the teachings of Bodnar. Applicant asserts that the query is not whether one of ordinary skill in the art *could have* made the claimed invention. Instead the query is *would*, at the time of invention, one of ordinary skill in the art *have* been motivated to make the claimed invention. *See*, M.P.E.P. § 2145 (X) (B) (stating that varying the parameters of a disclosure absent some indication of which parameters are important is an "obvious to try" type argument and constitutes impermissible hindsight reconstruction). Additionally, the Supreme Court recently restricted the appropriateness of the obvious to try argument to situations where there are "predictable solutions". *See, KSR Int'l v. Teleflex Inc.*, 500 U.S. \_\_\_\_ (2007). Applicant's respectfully asserts

that, at the time of invention, the benefit of using its specifically claimed polyols was not predictable.

Applicant notes that Bodnar discloses rigid polyurethane-polyisocyanurate foams. *See*, Bodnar abst. Without wishing to be bound by the theory, Applicant asserts that Bodnar is interested in achieving a polyisocyanurate network. Such networks require the use of a trimerization catalyst, which promote isocyanurate formation only at high Indexes—on the order of 2.0 to 3.5. *See*, Bodnar at Col 8, lines 32-34 (requiring the use of a trimerization catalyst). These results are seen in the examples of Bodnar, which exhibit Index ranging from 2.5 to above 3.1. Trimerization catalysts are generally considered ineffective at Indexes below 2.0, and Bodnar lists a lower Index limit of 1.5. *See*, The Polyurethanes Book, Randall, D.; Lee, S., p. 232 (stating, “polyisocyanurate (PIR) foams are made with indexes in the range of 200 to 350.”). A copy of the relevant portion of the reference is attached hereto.

Therefore, one of ordinary skill, relying on Bodnar, would not have seen the benefit of conducting experiments at an Index lower than 1.5, which is outside of Applicant’s claimed range. Moreover, one of ordinary skill in the art would not have been able to predicate the beneficial result seen by excluding the trimerization catalyst, decreasing the Index limit, and incorporating the claimed polyol.

Newly presented Claim 21 requires that the foaming agents consist solely of water, carboxylic acid, or mixtures thereof. Applicant asserts that without additional blowing agents the foam will have a thermal conductivity that is not suitable for the uses anticipated by Bodnar. *See*, Bodnar Col. 3, lines 5-10 (stating, “[t]he rigid foams … are particularly suited for … insulation for tanks, pipes, refrigerator and freezer cabinets and the like); see also, The

Polyurethanes Book, Randall, D.; Lee, S., p. 236 (including a chart listing the thermal conductivity of CFC-11, HCFC-141b, HCF-134a, and CO<sub>2</sub> as 0.0074, 0.0091, 0.0123, and 0.0153 W/n-K respectively.). A copy of the relevant portion of the reference is attached hereto.

The Office Action asserts that the “omission of an element with consequent loss of function is obvious.” Applicant, however, asserts that one does not arrive at its claimed inventions through the mere omission of the blowing agent element within Bodnar. Instead, one would have to omit the blowing agent element, as well as select a hydrogen containing derived polyols of the equivalent weights, and substantially reduce the Index. Applicant asserts that Bodnar’s disclosure of its intended use teaches away from such a combination of changes. Accordingly, such a combination of changes could only be made by relying on impermissible hindsight reconstruction.

Newly presented Claim 22 requires that the foam’s break strain to yield strain ratio is at least about 1.25. Applicant asserts that the polyisocyanurate foams of Bodnar are known to be brittle, relative to Applicant’s disclosed foams. Accordingly, Applicant asserts that the foams of Bodnar would exhibit a relatively lower break strain. Therefore, the ratio of break to yield strain is likely to be lower than Applicant’s claimed range of about 1.25.

Applicants therefore respectfully request that the rejection to claims 1-16 and 19 and 20 under 35 U.S.C. § 103(a) in view of Bodnar be withdrawn, and an indication of allowability directed toward claims 1-16 and 19-22 be entered.

2. Request for One-Month Extension of Time

Pursuant to 37 C.F.R. § 1.136(a), Applicants hereby request a one (1) month extension of time to file a response to the Office Action Mailed January 4, 2007. This request extends the original due date of April 4, 2007 one (1) month to May 4, 2007. Applicant has enclosed the \$120 fee for a large entity.

3. Conclusion

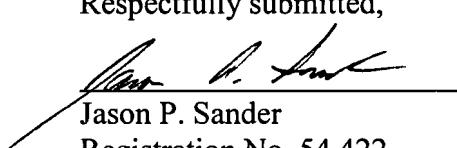
In view of the foregoing remarks, Applicant respectfully submits that the application is now in condition for allowance, and respectfully requests issuance of a Notice of Allowance directed towards the pending claims.

Applicant authorized the Commissioner to charge the \$120.00 fee for a one-month extension of time to Deposit Account 07-0153, Gardere Wynne Sewell LLP. Should any other fee be due in connection with the filing of this document, the Commissioner for Patents is hereby authorized to deduct said fee from Deposit Account No. 07-0153.

Please date stamp and return the enclosed postcard to acknowledge receipt of this material.

5/3/07  
Date

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